

**REMARKS**

Reconsideration of this application and entry of this Amendment is respectfully requested.

New claim 25 replaces claim 13 and recites the method in terms of deterring the build up of sebum on the surface of the scalp hair to thereby maintain the scalp hair in a cleaner state between shampooings. Support for the language contained in claim 25 can be found in paragraphs [002], [004], [009], [011], [027], [033] and [034] of published application 2004/0265258 A1. The dependencies of the claims 20 and 22 have been changed to depend from new claim 25. The dependency of claim 14 has been changed to depend from claim 24 and this claim now covers the preferred elastomers. Support for Polysilicone-11 appears in paragraph [019]. New claims 26 – 28 have also been added to claim specific embodiments of the invention. Claim 15 has been amended to depend from claim 26. No new matter has been added.

The rejection of claims 13 to 24 under the second paragraph of 35 USC § 112 as being indefinite in reciting a “*non-emulsion*” hair care composition is believed obviated in view of the deletion of this language. However, Claim 24 and new Claim 25 both state that the cross-linked silicone elastomer is “non-emusifying”. Support is found at paragraph [018].

The rejection of claims 13-24 under the first paragraph of 35 USC § 112 as failing to comply with the written description requirement is respectfully traversed. The Examiner maintains the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey it to one skilled in the relevant art that the inventors at the time the application was filed had possession of the claimed invention. Applicants respectfully disagree.

More specifically, the Examiner refers to independent claims 13 and 24 as reciting “*mixtures thereof*” which does not have support in the specification as originally filed to contemplate the mixture of various esters

Applicants respectfully invite the Examiner’s attention to paragraph [027] in the published application, which states,

*“The compositions of the present invention include at least one water dispersible or water soluble ester.”*

It is respectfully submitted that the language “*at least one*” would be understood as equivalent to “mixtures thereof” to one of ordinary skill in the art. Therefore, it is respectfully submitted that the specification provides ample support to contemplate a mixture of the various esters. Furthermore, Applicants also invite the Examiner’s attention to MPEP 2173.05(e), which states:

*“The mere fact that a term or phrase is used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.”*

It is respectfully submitted that the above claim terminology is consistent with the guidelines set forth in the MPEP.

Nonetheless, Applicants have amended the claims to recite language that has identical support in the specification, by reciting in claim 24 “*one or more*” non-emulsifying silicone elastomers; “*at least one water dispersible or water soluble ester*”, and “*at least one surfactant*”. This language appears in the

specification in paragraphs [019], [027], [030], respectively in Applicants' published application 2004/026258 A1.

The Examiner rejected claim 15 as being indefinite in reciting the amount of the ester as varying from about 0.1 to 10 wt % and refers to page 9 of the specification wherein the amounts of the ester appear. See also paragraph [029] of the published application. Evidently, because the amount "10%" has not been specifically recited in the application, the Examiner considers that this amount has not been contemplated as part of the invention. Applicants respectfully disagree.

It is well known that it is not necessary for the specification to have literal support. *In re Wertheim et al*, 191 USPQ 90 (CCPA 1976) states:

*"That what appellants' claim as patentable to them is less than what they describe as their invention is not conclusive if their specification also reasonable describes that which they do claim. Inventions are constantly made which turn out not to be patentable, and the applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable... To rule otherwise would let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the species when he filed. Since the patent law provides for the amendment during prosecution of claims, as well as the specification supporting the claims, 35 USC 132, it is clear that the reference to 'particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention' in the second paragraph of 35 USC 12 does not prohibit the applicant from changing what he 'regards as his invention'." (page 97)*

It is also worthwhile to consider the following observation by Judge Learned Hand:

*"If when (applicants) yield any part of what they originally believed to be their due, they substitute a new 'invention,' only two courses will be open to them: they must at the outset either prophetically divine what the art contains, or they must lay down a barrage of claims, starting*

*with the widest and proceeding by the successive incorporation of more and more detail until all combinations have been exhausted which can by any possibility succeed. The first is an impossible task; the second is a custom already more honored in the breach than in the observance, and its extension would only increase that surfeit of verbiage which has for long been the curse of patent practice, and has done much to discredit it. It is impossible to imagine any public purpose which it could serve.” (Engineering Development Laboratories v. RCA, 68 USPQ, 241-242 (CA2 1946) as quoted in In re Driscoll, 195 USPQ 434, 438 (CCPA 1977)).*

Nonetheless, Applicants have amended Claim 15 to recite that the concentration range of the ester is “from about 0.1 to 5 wt %”. Support for this range is found in paragraph [029] and in the Examples, paragraphs [044] through [048].

The Examiner has rejected claim 19 because it recites “*about 1%*” which does not appear in the specification. The Examiner notes that page 8 of the specification provides support for “1%”, not for “*about 1%*”. Applicants respectfully disagree. The specification language also appears in paragraph [025] of Applicants’ published application. It is respectfully submitted that one skilled in the art recognizes that the phrase “*about 0.01 to 1%*” is equivalent to “*about 0.01 to about 1%*”. It is respectfully submitted that the Examiner appears to be splitting hairs because of lack of literal support which, as already noted, is not a requirement of the patent law. See In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) (holding that a claimed range of “between 35% and 60%” was supported by the disclosure of the range “25 to 60%” and specific examples at 36% and 50%); MPEP § 2163.05(iii).

Accordingly, in view of the above arguments and amendments, it is respectfully submitted that this ground of rejection be reconsidered and withdrawn.

Before discussing the prior art rejections under 35 USC § 103, it is believed worthwhile at this point to briefly discuss the novel and unobvious aspects of Applicants' claimed invention.

Applicants' claimed invention recites a method for deterring the buildup of sebum on the surface of the scalp hair, thereby maintaining the scalp hair in a cleaner state between shampooings. The claimed method recites forming a rinse-off hair care composition that comprises a non-emulsifying cross-linked silicone elastomer or silicone elastomer powder in an amount sufficient to deposit a sebum-absorbing level of the cross-linked silicone elastomer on the hair or scalp, and at least one water dispersible or water soluble ester as stated in the independent claim 25, such as olive oil esters, polyethyleneglycol esters, polyglycerol esters, sucrose esters, silicone esters wherein the esters have an HLB of about 8.5 and above. A suitable surfactant and water are also included.

The hair care composition is contacted with the scalp hair to form treated scalp hair. The treated scalp hair is then contacted with a sufficient amount of water to rinse off the hair care composition. The treated scalp hair is then dried or allowed to dry. The dried, treated scalp hair deters the buildup of sebum on the hair surface and maintains the treated scalp hair in a cleaner state between shampooings.

As noted in Applicants' previous Amendment, the hair care composition prevents sebum from wicking up the shaft of the hair, thereby reducing sebum buildup. The hair stays cleaner for a longer period of time, while providing a smooth feel and long-lasting conditioning effects.

The deterrence of sebum buildup on the scalp hair has resulted from the synergistic combination of the claimed non-emulsifying silicone elastomer and the water dispersible or water soluble ester hair treating composition, therefore

enabling the hair to stay cleaner for a longer period of time between shampooings. See paragraphs [015], [017] and [037] in Applicants' published application 2004/0265258 A1.

The superior benefits of the claimed invention are demonstrated in the examples which also include comparative tests. See paragraphs [047], [048] and [049] in Applicants' published application. Therein, a Control Composition A was prepared, which did not contain a non-emulsifying silicone elastomer or a water dispersible or water soluble ester. Composition B includes a silicone elastomer added to Control Composition A. No water dispersible or water soluble ester was included. Composition C includes a water dispersible or water soluble ester added to Control Composition A. No non-emulsifying silicone elastomer was included. Composition D is the inventivce hair care composition that includes a sufficient amount of non-emulsifying silicone elastomer and water dispersible or water soluble ester. These compositions were tested on actual hair.

The results appear in Tables 1-10 and demonstrate the unique properties obtained with Applicants' claimed method. It would be readily apparent to one skilled in the art that the hair treating composition in Applicants' claimed method comprising the non-emulsifying silicone elastomer and water dispersible or water soluble ester of Composition D outperformed Compositions A, B, and C, thereby demonstrating the unexpected improvement of Applicants' claimed method in deterring the buildup of sebum on the scalp and providing enhanced combing properties.

Turning now to the rejection, claims 13-24 have been rejected under 35 USC § 103 as unpatentable over Bergmann et al (US 6,432,393) in view of Jakobson et al (US 5,466,719) or Jakobson et al (US 5,247,114). This ground of

rejection is respectfully traversed, and will be viewed in the context of new claim 25.

Bergmann relates to aqueous and non-aqueous hair care compositions (column 2, lines 8-10). The composition also includes one or more elastomeric resinous materials that can be silicone and non-silicone elastomers (column 2, lines 39-44). The Examiner admits in the Office Action at the top of page 5 that Bergmann does not teach the use of esters. In addition, Bergmann neither discloses nor suggests a method for deterring the buildup of sebum on the surface of scalp hair to thereby maintain the scalp hair in a cleaner state between shampooings.

Jakobson ('114) relates to a fatty acid polyglycerol ester composition, primarily for skin care, which does not contain a non-emulsifying silicone elastomer as claimed in the present invention. There is also no disclosure or suggestion in Jakobson of a method for deterring the buildup of sebum on the surface of scalp hair.

Jakobson ('719) discloses polyglycerol fatty acid ester mixtures as skin care compositions. Jakobson ('719) relates primarily to a bath additive, skin cleansing function (column 5, lines 26 to 55). It would be evident to one skilled in the art from reading the disclosure of Jakobson at column 10, lines 44-51, that the primary objective of the Jakobson ('719) compositions is for a skin cleansing effect. Jakobson ('719) does not disclose a non-emulsifying silicone elastomer as claimed by Applicants, and does not disclose or suggest a method for deterring the buildup of sebum on the surface of scalp hair.

Consequently, there is no reasonable basis for combining the teachings of Bergmann with the teachings of either or both Jakobson patents in a manner which would collectively suggest Applicants' claimed invention because none of the references discloses or suggests the method claimed by Applicant.

Accordingly, reconsideration and withdrawal of this ground of rejection is respectfully requested.

The rejection of claims 14-16, 19-20 and 22-24 under 35 USC § 103 as unpatentable over *Ansher-Jackson et al* (US 5,100,657) as evidenced by the Sisterna-Sucrose Esters brochure (Autumn 2004) is respectfully traversed. This rejection will also be commented upon in the context of new claim 25.

*Ansher-Jackson* relates to a hair conditioning composition comprising silicone conditioning agents, cationic surfactant conditioning agents and fatty alcohol conditioning agents (column 3, line 59 to column 4, line 23). *Anschere-Jackson* does not disclose or suggest Applicants' claimed method for deterring the buildup of sebum on the surface of scalp hair. The Examiner states in the middle of page 7 of the Office Action:

*"One cannot immediately envisage the instant water soluble surfactant (sucrose stearate) or silicone elastomer."*

It appears that the Examiner is indirectly admitting that the reference does not disclose the claimed invention. If this is not so, Applicants request clarification of the meaning of this sentence.

The Examiner's reliance on the Sisterna-Sucrose Ester brochure appears unjustified in view of the fact that the effective date of this reference is Autumn 2004, whereas Applicants' application was filed on the December 30, 2003. Accordingly, the Sisterna-Sucrose Ester reference is not prior art under Section 103. It is respectfully submitted that this ground of rejection be reconsidered and withdrawn.

Applicant further submits that even if the Sisterna reference is available, it is not dispositive of the issue. The compositions of *Ansher-Jackson* specifically require a water *insoluble* surfactant (col. 4, lines 6-8). Such water

insoluble surfactants are disclosed in Ansher-Jackson at col. 6, line 29 to col. 13, line 5. Water insoluble sucrose stearate is identified at col. 12, line 49, amongst literally thousands of other water insoluble surfactants. The instantly claimed compositions require a select ***water dispersible or water soluble*** ester as specified in the Claims 24 and 25.

Accompanying this amendment is a copy of a Mitsubishi-Kagaku Foods Corporation: Surfhope SE Pharma. This reference makes clear that sucrose esters are available in a range of HLBs. Ansher-Jackson contemplates water insoluble sucrose esters, i.e., those having very low HLB. In contrast, the present invention requires that its esters are water dispersible/water soluble having an HLB of about 8.5 and above. The practitioner in this art would not use the sucrose esters identified in Ansher-Jackson in applicants' claims since Ansher-Jackson mandates a totally different type of material. Indeed, as the practitioner of ordinary skill realizes, materials become increasingly hydrophilic (water soluble) as HLB increases. Ansher-Jackson simply could not have envisioned the sucrose stearates of the present invention simply because these materials are quite water soluble, in complete contradiction to the essential requirement of the disclosure of Ansher-Jackson.

Claims 13-24 have been rejected under 35 USC § 103 as unpatentable over EP0855178 in view of Jakobson et al (US 5,466,719). This ground of rejection is respectfully traversed and will be considered in the context of the currently pending claims 14-25.

As already noted, Applicants' claimed invention relates to a method for deterring the buildup of sebum on the surface of scalp hair, thereby maintaining the scalp hair in a cleaner state between shampooings. EP '178 does not disclose or suggest a method for deterring the buildup of sebum on the surface of scalp hair in

accordance with Applicants' claimed invention. In addition, the Examiner admits on page 8 of the Office Action that EP '178 does not teach the esters that form a part of Applicants' claimed invention.

The deficiencies of EP '178 are not resolved by the combination of Jakobson et al. As already noted, Jakobson ('719) does not relate to a method for deterring the buildup of sebum on the surface of scalp hair. Jakobson ('719) relates primarily to a bath additive, skin cleansing function (column 5, lines 26 to 55). It would be evident to one skilled in the art from reading the disclosure of Jakobson at column 10, lines 44-51, that the primary objective of the Jakobson ('719) compositions is for a skin cleansing effect.

There is no disclosure or suggestion in Jakobson ('719) of deterring the buildup of sebum on the surface of the scalp hair or obvious basis for suggesting Applicants' claimed method in the collective combination of Jakobson ('719) with EP 0855178.

Thus, EP '178 does not disclose the esters that form a part of Applicants' claimed method, and does not disclose a method for deterring the buildup of sebum on scalp hair. Jakobson ('719) primarily relates to skin cleaning compositions and does not disclose a method for deterring the build up of sebum on scalp hair. The combination of these disparate teachings does not collectively suggest Applicants' claimed invention in an obvious manner.

Accordingly, reconsideration and withdrawal of this ground of rejection is respectfully requested.

In view of the above amendments and remarks, it is respectfully submitted that this application is now in condition for allowance and such favorable action is respectfully requested.

Respectfully submitted,

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